

Application No.: 09/505,913
Amendment dated: January 25, 2006
Reply to Office Action of: July 25, 2006

REMARKS

Applicant is submitting a Request for Continued Examination with a preliminary amendment in response to a final office action dated July 25, 2006. The Examiner issued a first office action and made it final based on her indication that “[all] claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.”

MPEP 706.07(b). Final Rejection, When Proper on First Action [R-1]

The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.

Further, it would not be proper to make final a first Office action in a continuation-in-part application where any claim includes subject matter not present in the earlier application.

Applicant respectfully submits that the claims presented were amended in scope and therefore, cannot possibly be drawn to the same invention. Nevertheless, Applicant is presenting amendments to the claims here to advance prosecution and requests reconsideration of this application.

35 U.S.C. Section 103 Rejections

In paragraph 3 of the office action the Examiner maintains her rejections of claims 16-42, 45-72, 75-105, 108-111 as unpatentable over Shavit et al. (US 4,799,156, hereinafter “Shavit”) in view of Smith (US 5,450,123), and further in view of Filepp et al. (US 5,347,632, hereinafter “Filepp”) for the same reasons she has asserted before in the last Office action and repeated below.

At the outset, the Examiner in response to applicant’s argument that the examiner’s conclusion of obviousness is based upon improper hindsight reasoning, indicates that “it must be

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recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper." See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant respectfully submits the following governing criteria and requests the Examiner to reconsider her rejection of the claims here based on the three references.

Governing Criteria

At the outset, Applicants acknowledge the Examiner's reasoning but additionally urge the following legal reasoning and case law as the bases for rejections under 35 U.S.C. Section 103. For obviousness rejections, the establishment of a *prima facie* case of obviousness requires that **all the claim limitations** must be taught or suggested by the prior art. MPEP § 2143.03 The establishment of a *prima facie* case of obviousness requires that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. MPEP § 2143.03

To resolve the issue of patentability based on obviousness, the Examiner must not only look to the teaching in the asserted references that meets the claimed limitations, but must also **point to the motivation in the asserted references** that invites a combination in the event one reference is devoid of a particular teaching. Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)). Rather, obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention **are available** to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993).

An Examiner may often find every element of a claimed invention in the prior art. "Virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983); see also *Richel, Inc. v.*

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Sunspool Corp., 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the Examiner **must show reasons that the skilled artisan, confronted with the same problems** as the inventor and with no knowledge of the claimed invention, **would select the elements from the cited prior art references for combination in the manner claimed.**

Discussion of the 103 Rejections

In paragraph 3 of the office action, claims 16-42, 45-72, 75-105, and 108-111 are rejected under 35 U.S.C. Section 103(a) as being unpatentable over Shavit et al., in view of Smith, and further in view of Filepp et al. In paragraph 4 of the office action, claims 43-44, 73-74 and 106-107 are rejected under 35 U.S.C. Section 103(a) as being upatentable over Shavit, Smith and Filepp, as applied to claims 16, 45, and 77 above, and further in view of Donald et al.

With respect to claims 16-42, 45-72, 75-105 and 108-111, the Examiner continues to argue that:

Shavit differs from claims 16-42, 45-72, 75-105, 108-111 in that it does not specify a dynamic video system. However, Smith teaches the desirability of including a camera at a representative terminal so that direct, real-time, point-to-point video communication can take place between a customer and the representative (col. 3, lines 26-27; col. 4, lines 25-28; moving pictures are communicated via AT&T 2500 video telephone sets, col. 1, lines 27-28) such that it would have been obvious to an artisan of ordinary skill to incorporate such dynamic, full-motion video communication, as taught by Smith, within the system of Shavit in order to provide a real-time video as well as audio communication between the customer and representative. In this way, a more realistic face-to-face meeting can take place.

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Further, Smith teaches the desirability of allowing buyer access to a vendor supplied video image stored in a video file server (video source and database 6) for enhancing sales communication with the use of video (col. 1, line 51 - col. 3, line 27) such that it would have been obvious to an artisan of ordinary skill to incorporate such use of video, as taught by Smith, within the method of Shavit in order to allow a buyer to view the desired goods or services.

The combination of Shavit and Smith further differs from the claims in that although Smith provides for supplying customized information (col. 5, lines 48+), it does not specify storing in memory identification data of an interested buyer in association with a designated area of commercial interest. However, Filepp teaches the desirability of storing user data in association with a designated area of commercial interest in order to provide targeted advertisements according to collected parameters (col. 9, lines 27-47) such that it would have been obvious to incorporate such customization of advertisements, as taught by Filepp, within the combination of Shavit and Smith so that potential buyers receive targeted promotional e-mail messages regarding products that would more likely interest the particular buyer.

First of all, Shavit does not teach selectivity in the context of the claimed inventions. In Shavit, the IMM system does not selectively select vendors based on some criteria. One party to the transaction is specifically selected by the other party to the transaction. Shavit's system is completely different from the claimed invention. On page 3 of the office action, the Examiner indicates that:

Shavit discloses a commercial transaction communication system (Interactive Market Management System 50), the system being adapted for use with an on-line computer service (Shavit provides for access to a variety of information sources and database providers, e.g. Dialog; col. 7, lines 9-15) comprising:

an interface (personal computers 62, 64 and communication interface 79; col. 5, line 28 – col. 6, line 51);

an audio system (interactive conversational service; col. 7, line 58 – col. 8, line 4);

a text system (mailbox service, col. 8, lines 12-22; col. 11, line 52 – col. 12, line 18; transaction service, col. 12, line 42 – col. 14, line 21, facsimile service, col. 14, line 22);

a storage memory (database stores subscriber data and request data; col. 7, lines 23-46; col. 25, lines 28-50);

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a control computer unit (central processor 80) utilizing request data entered by an active buyer to seek responses from a select vendor from a plurality of vendors (one or more Request for Quotations (RFQ's) **are entered by the buyer to seek bids from one or more distributors**; col. 13, lines 10-34) and directing an electronic mail message relating to the select vendor to the active buyer via the on-line computer service (system 50 provides email messages to each user, including bids in response to requests for particular goods or services input by the user, promotions, and other information of particular interest to buyers; col. 11, lines 52 – col. 12, line 26; col. 13, lines 25-27; col. 18, lines 44-49; col. 20, lines 2-39.

The text at column 13, lines 10-34, that is pointed to by the Examiner, discloses that a buyer may enter or modify a request for a bid by a buyer and the system prepares a bid by recalculating the price and the terms of the bid in order to submit an automatic bid. This does not satisfy the claimed invention as defined by the claims here. In addition, Claims 36, 45, 67, 77, 99, 100, and 109 recite electronic data interchange (EDI), which is not disclosed in Shavit nor Smith or any of the references asserted by the Examiner. The Examiner does not address this feature of the claims. Claims 16, 45, 77, and 109 are amended to emphasize the differences.

Favorable reconsideration of this application is respectfully requested.

Respectfully submitted,

Dated: January 25, 2007

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